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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,989	09/25/2003	Michael Wisniewski	PROS1130	4517

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EXAMINER	
SAINDON, WILLIAM V	

ART UNIT	PAPER NUMBER
3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/670,989	WISNIEWSKI ET AL.	
	Examiner	Art Unit	
	WILLIAM V. SAINDON	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-9,12-17,19,20,23,24,28,29 and 33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-9,12-17,19,20,23,24,28,29 and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The following FINAL Office Action is in response to Applicant's submission received November 10, 2008. Claims 1, 2, 4, 6-8, 12, 13, 15, 16, 19, 23, 24, 28, and 33 were amended. Claims 5, 10, 11, 18, 21, 22, 25-27, and 30-32 were canceled. No claims have been added. Therefore, claims 1-4, 6-9, 12-17, 19, 20, 23, 24, 28, 29, and 33 are pending.

Response to Amendment

2. The 35 USC § **101 rejection** of claims 1-4, 6-9, 23, 24, and 33 is **not withdrawn** in light of Applicant's amendments. Applicant amended the preamble of the claims to require a "computer-implemented" method. However, the preamble does not serve as a limitation and fails to be a "meaningful" tie to the claims. Under the broadest reasonable interpretation, "computer-implemented" does not mean that any step is performed by a computer, but could mean that a human uses the computer to assist in the implementation of the claimed steps. Additionally, the Board of Patent Appeals and Interferences has directly held that the preamble does not serve as a meaningful limitation for purposes of § 101 analysis. See Ex parte Langemyr, pp. 19-20 (May 28, 2008) (available at USPTO website under Informative Board opinions).

Further, the "analyzing" and "updating" steps of claim 1 being "on the computer" does not serve to tie the steps to a computer. Under the broadest reasonable interpretation, a human being working on the computer (using email, a calculator, etc.)

could be performing the steps. It is not clear that the computer itself is performing the steps.

Response to Arguments

3. Applicant's arguments with respect to 35 USC § 102 have been considered but are moot in view of the new ground of rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, 6-9, 23, 24, and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention as claimed is directed towards the statutory category of a process. The steps recited do not qualify as a statutory process. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The claims are not tied to another statutory class. The steps recited either do not require a particular apparatus (e.g. a particular computer), or only mention a nominal recitation of a computer (e.g. preamble). Therefore, the claims are non-statutory.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 1-4, 6-9, 12-17, 19, 20, 23, 24, 28, 29, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi et al. (US 6,895,405)**.

As to claim 1, Choi discloses:

on the computer, analyzing the distribution of responses to all actions of the set of actions presented to the customers associated with the profile, wherein the analysis

identifies one action of the set of actions having a desired outcome (see col. 4, lines 56-67, noting that responses to survey questions are gathered to determine which questions best identify a given segment; col. 5, line 53 - "calculate response distributions;" claim 1, "determining a response distribution" from survey questions); and

on the computer, updating the action selection algorithm, wherein future actions presented to customers associated with the profile are selected based on the updated action selection algorithm (see col. 4, lines 63-67, noting that price-of-entry variables are removed from the survey, such that the list of available survey questions is reduced when they are not predictive for that segment profile).

Choi fails to explicitly disclose:

matching a plurality of customers to a profile;

selecting an action from a set of actions associated with the profile using an action selection algorithm;

presenting the action to a customer of the plurality of customers associated with the profile;

receiving a response to the action from the customer;

repeating the selecting, presenting, and receiving steps for each customer of the plurality of customers so as to determine a distribution of customer responses to the actions.

However, these steps are obvious given the survey analysis technique presented in Choi. For example, Choi suggests that surveys are presented to customers (see col. 4, lines 56-65). The questions presented to the customers represent actions. The

response to the question is the customer response. This would naturally be done over a body of customers to create the desired distribution. These responses are gathered in Choi for the purpose of finding the best questions indicative of a particular profile (id.). Therefore this cycle would be repeated several times. Further, the express purpose of Choi is to develop clusters, also known in the art as segments or profiles (see col. 1 - Field of Invention). A "cluster" is a group of people who act alike. Therefore Choi is also matching customers to profiles because he is determining which questions indicate a particular profile (by eliminating "price-of-entry" variables).

It would have been obvious to a person having ordinary skill in the art at the time of invention that the method for determining the effectiveness of survey questions presented in Choi would also have a data-gathering step by gathering responses to survey questions for the purpose of applying the analysis to data and determining pertinent survey questions indicative of customer clusters.

As to claim 2, Choi discloses collecting information on the plurality of customers (see e.g. col. 5, lines 35-60, noting the various data collected on customers pertaining to their responses).

As to claim 3, Choi discloses augmenting the information with external sources (see col. 3, lines 1-16, noting survey questions are asked of individuals, who are external sources to the marketing firm).

As to claim 4, Choi discloses defining a customer need (see col. 2, lines 12-17, noting segments align with needs of customers).

As to claim 6, Choi discloses the set of actions is specific to the profile (see col. 4, lines 56-67, noting that the questions are asked because of their link to a particular segment/profile/cluster, and therefore are specific to that profile).

As to claim 7, Choi discloses a history of responses for the profile in selecting an action from the set of actions (see col. 5, lines 17-22, noting the responses are a history of the customer's responses that are used to determine the effectiveness of a question, which is used to determine if it is asked to future customers).

As to claim 8, Choi discloses formulating a response forecast using at least one customer's response (see col. 6, line 10, noting the score gives the forecast of the relevance of the responses to the question).

As to claim 9, Choi discloses updating the response forecast based on the at least one customer's response (see id., noting that more than one response is used to calculate the forecasted Babbitt score).

Claims 12-15 recite substantially similar limitations as claims 1-4 and are rejected for similar reasons.

As to claim 16, Choi discloses matching a plurality of customers to a profile is done using a second algorithm (see col. 6, line 15 et seq., noting the benefit clustering algorithms that provide further clustering of profiles).

Claims 17, 19, and 20 recite substantially similar limitations as claims 6, 8, and 9 are rejected for similar reasons.

Claims 23 and 24 recite substantially similar limitations as claims 1 and 6 and are rejected for similar reasons.

Claims 28 and 29 recite substantially similar limitations as claims 1 and 6 and are rejected for similar reasons.

Claim 33 recites substantially similar limitations as claim 1 is rejected for similar reasons.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM V. SAINDON whose telephone number is (571)270-3026. The examiner can normally be reached on M-F 7:30-5; alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/wvs/

/Beth V. Boswell/
Supervisory Patent Examiner, Art Unit 3623